

Commissioner for Patents  
February 15, 2005  
Page 8 of 13

Serial No. 10/733,841  
Art Unit: 3661 Examiner: Cuong H. Nguyen  
IBM Docket No.: AUS920031011US1(4032)

### REMARKS

Claims 1-24 are pending and claims 1-24 stand rejected. The Office action rejected claims 1-5 and 7-24 under 35 USC § 102(e) as being anticipated by Whitman U.S. Pat. 6,526,351 (hereinafter "Whitman"). The Office action further rejected claim 6 under 35 USC § 103(a) as being unpatentable over Whitman in view of Bodin U.S. Pat. 6,813,559 (hereinafter "Bodin").

Independent claims 1, 11 and 19 have been amended solely to provide further clarification of the invention. Applicant respectfully believes that the rejections have been traversed in light of the following remarks. All of the claims in the present application are believed to be patentable over any combination of these references and the Examiner's reconsideration is respectfully requested.

#### Claim rejections under 35 USC § 102

Claims 1-5 and 7-24 stand rejected under 35 USC § 102(e) as being anticipated by Whitman. Applicants respectfully suggest that the rejections with respect to claims 1-5 and 7-24 are traversed in the following remarks.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single reference.<sup>1</sup> Furthermore, the identical invention must be shown in as complete detail as is contained in the claim.<sup>2</sup>

#### Claims 1-10

In regards to the amended independent claim 1, the Office action fails to establish a prima facie case of anticipation by Whitman because citations of Whitman provided as support for the rejections fail to describe, suggest or teach "each and every element as set forth in the claim[s]". In particular, amended claim 1 states:

<sup>1</sup> *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987).

<sup>2</sup> *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Commissioner for Patents  
February 15, 2005  
Page 9 of 13

Serial No. 10/733,841  
Art Unit: 3661 Examiner: Cuong H. Nguyen  
IBM Docket No.: AUS920031011US1(4032)

receiving from a user at a current location differential information, the differential information indicating a difference between the current location and a particular, different location....

Whitman, in contrast, does not disclose or suggest receiving from a user at a current location differential information. Whitman teaches an interactive multimedia guide "that is implemented using a GPS (Global Positioning System) system enabled map program with a GIS (Geographic Information System) database running on a computer" (Specification, column 2, lines 52-55). Whitman provides that the disclosed system may display a map of a selected tour and the location of the GPS receiver and user on the map (Specification, column 4, lines 24-27). Whitman further provides that during a tour the system may provide to the user audible directions to a different destination while en route to a first destination (Specification, column 4, lines 27-29). While Whitman does teach an interactive multimedia guide system providing directions between a user's current location and another location, Whitman does not disclose or suggest receiving differential information *from a user* and is thus readily distinguishable from the present invention. Whitman simply does not teach or suggest, expressly or inherently, the teachings of amended independent claim 1. Whitman, in fact, teaches away from the teachings of amended independent claim as a user of Whitman's interactive multimedia guide who needs to receive directions to a location certainly would not be in a position to provide directional information to the interactive multimedia guide.

Whitman also fails to disclose or suggest "providing a location-based service, wherein the location-based service produces results that are at least partially based on the particular location" as taught by amended claim 1. Whitman teaches providing a location-based service based on the *current* location of the user (Specification, column 4, lines 39-55; *see also*, Specification, column 5, lines 25-45). For example, Whitman discloses providing restaurant recommendations that are "reasonably close" to the user's current location or "in the vicinity" of the user (Specification, column 5, lines 25-45). Whitman simply does not disclose or suggest providing a location-based service, wherein the location-based service produces results that are at least partially based on the particular location.

Whitman does not teach or suggest, expressly or inherently, multiple limitations of amended claim 1 for the reasons described above and other reasons. Accordingly, Applicant

Commissioner for Patents  
February 15, 2005  
Page 10 of 13

Serial No. 10/733,841  
Art Unit: 3661 Examiner: Cuong H. Nguyen  
IBM Docket No.: AUS920031011US1(4032)

respectfully requests that the rejection of claim 1 be withdrawn and that claim 1 be allowed. Further, claims 2-10, being dependent upon claim 1, incorporate the limitations of claim 1. Applicant therefore respectfully requests that these rejections be withdrawn and claims 2-10 be allowed. The Office action's individual rejections of particular dependent claims are now moot in light of the arguments presented above and need not be addressed.

#### Claims 19-21

In addition, Whitman does not teach or suggest, expressly or inherently, multiple limitations of amended claim 19 for the reasons described above for claim 1 as well as other reasons. Further, claims 20-21, being dependent upon claim 19, incorporate the limitations of claim 19. Accordingly, Applicant respectfully requests that the rejection of claims 19-21 be withdrawn and that claims 19-21 be allowed.

#### Claims 11-18

Similarly, Whitman does not teach or suggest, expressly or inherently, all of the limitations of amended independent claim 11 for the reasons as described previously regarding claim 1, among other reasons. In particular, Whitman does not teach or suggest "a user interface for receiving user input, wherein the user input comprises differential information", as taught by amended independent claim 11, as the interactive multimedia guide of Whitman does not provide receiving differential information from a user, instead only teaching displaying directions to an ancillary location to the user (Specification, column 3, lines 20-42). Neither does Whitman disclose or suggest a "service module providing a location-based service based on the particular location" as taught by amended independent claim 11. As described previously, Whitman teaches providing information based on the *current* location of the user (Specification, column 4, lines 39-55; *see also*, Specification, column 5, lines 25-45) and does not disclose or suggest providing a location-based service based on a particular, different location.

Whitman does not teach or suggest, expressly or inherently, multiple limitations of amended claim 11 for the reasons described above and other reasons. Accordingly, Applicant respectfully requests that the rejection of claim 1 be withdrawn and that claim 11 be allowed. Further, claims 12-18, being dependent upon claim 11, incorporate the limitations of claim 11. Applicant therefore respectfully requests that these rejections be withdrawn and claims 12-18 be allowed.

Commissioner for Patents  
February 15, 2005  
Page 11 of 13

Serial No. 10/733,841  
Art Unit: 3661 Examiner: Cuong H. Nguyen  
IBM Docket No.: AUS920031011US1(4032)

#### Claims 22-24

Whitman does not teach or suggest, expressly or inherently, all of the limitations of amended independent claim 22 for the reasons as described previously regarding claim 1 and other reasons. In particular, Whitman does not teach or suggest "receiving a request from a user at a current location for a location-based service based on a particular location", as taught by amended independent claim 22. As described previously, Whitman teaches providing a location-based service based on the *current* location of the user (Specification, column 4, lines 39-55; *see also*, Specification, column 5, lines 25-45). Whitman also provides receiving a request from a user for a location-based service based on their *current* location (Specification, column 5, lines 25-45). Whitman does not disclose or suggest receiving a request for a location-based service based on a particular, different location.

In addition, Whitman does not teach or suggest "providing a location-based service based on the particular location" for the reasons described previously for claim 1. Whitman does not teach or suggest, expressly or inherently, multiple limitations of amended claim 22 for the reasons described above and other reasons. Accordingly, Applicant respectfully requests that the rejection of claim 22 be withdrawn and that claim 22 be allowed. Further, claims 23-24, being dependent upon claim 22, incorporate the limitations of claim 22. Applicant therefore respectfully requests that these rejections be withdrawn and claims 23-24 be allowed.

#### Claim rejections under 35 USC § 103(a)

Claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Whitman in view of Bodin. Claim 6 is dependent upon independent claim 1 and incorporates the limitations of claim 1. Amended independent claim 1 is patentable because, as described previously, none of the disclosed references, alone or in combination, disclose the limitations of amended independent claim 1. Claim 6 is thus also patentable and the Applicant respectfully requests that the rejection being removed and claim 6 allowed. Claim 6 is also patentable for the reasons described below regarding non-obviousness.

Commissioner for Patents  
February 15, 2005  
Page 12 of 13

Serial No. 10/733,841  
Art Unit: 3661 Examiner: Cuong H. Nguyen  
IBM Docket No.: AUS920031011US1(4032)

To establish a prima facie case of obviousness, three basic criteria must be met.<sup>3</sup> First, there must be a suggestion or motivation to modify or combine the references.<sup>4</sup> Second, there must be a reasonable expectation of success in the modification or combination.<sup>5</sup> Finally, the modification or combination must teach or suggest all of Applicants' claim limitations.<sup>6</sup>

As conceded by the Office action, Whitman does not disclose "wherein the differential information comprises an indication of height", an element of dependent claim 6. Bodin discloses a position of an unmanned aerial vehicle (UAV) being expressed in a height or altitude in an invention relating to orbiting a waypoint for a UAV. There is no suggestion or motivation in Whitman to modify or combine the teachings of Bodin with the interactive multimedia guide of Whitman. The interactive multimedia guide of Whitman is intended to provide an improvement upon existing tour books or maps by providing tour guides, itineraries, and the like (Specification, columns 2-3). As Whitman is intended to provide an improved traditional tour guide, it simply does not suggest the use of an indication of height, a feature unrelated to a traditional tour guide. Whitman and Bodin, either alone or in combination, do not teach or suggest, expressly or inherently, the teachings of dependent claim 6. Applicant respectfully requests that the rejection of claim 6 be withdrawn and that claim 6 be allowed.

#### CONCLUSION

In the present response, responded to the Office action's claim rejections under 35 USC §§ 102 and 103. In addition, Applicant has amended independent claims 1, 11, and 19 to further clarify the invention. Accordingly, Applicant believes that this response constitutes a complete response to each of the issues raised in the office action. In light of the amendments made herein and the accompanying remarks, Applicant believes that the pending claims are in condition for allowance. Accordingly, Applicant would request that the rejections be withdrawn, pending claims be allowed, and application advance toward issuance. If the Examiner has any questions, comments, or suggestions, the undersigned attorney would welcome and encourage a telephone conference at (860) 643-0102.

<sup>3</sup> Manual of Patent Examining Procedure §2142.

<sup>4</sup> *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991).

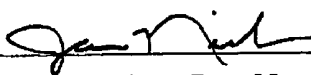
<sup>5</sup> *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986).

Commissioner for Patents  
February 15, 2005  
Page 13 of 13

Serial No. 10/733,841  
Art Unit: 3661 Examiner: Cuong H. Nguyen  
IBM Docket No.: AUS920031011US1(4032)

Respectfully submitted,

February 15, 2005  
Date

  
James L. Nickelson, Reg. No. 46,140  
Customer No.: 45557  
Schubert Osterrieder & Nickelson PLLC  
6013 Cannon Mtn. Dr, S14  
Austin, Texas 78749  
(512) 692-7297 (Telephone)  
(512) 301-7301 (Facsimile)  
Attorney for Applicant(s)

<sup>6</sup> *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974).